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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,145	11/30/2001	Brandon R. Mackay	14591.11	4556
22913	7590	11/18/2003	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			BRITTAIN, JAMES R	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/998,145

Applicant(s)

MACKAY ET AL.

Examiner

James R. Brittain

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2003 and 14 August 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16 is/are allowed.
- 6) ☒ Claim(s) 1-10, 13, 17 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 11, 12 and 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Weil (US 2704961).

Weil (figures 7-12) teaches eyeglass retainers comprising a cord 13' having a first end and a second end and first and second connectors 14' coupled to the first end and second ends of the cord 13' wherein the connector has hollow portion 15 and apertures 22, 23 in the tubular wall that are inherently capable of being secured to the earpiece and the temple of eyeglasses if so desired. The connectors are comprised of rubber that is elastic and would be inherently capable of being inserted over the earpiece of less curvature than that of the shown glasses so as to be placed on the temple of the eyeglasses. Since the connectors are made of rubber the openings in the tubular wall are also expandable. The combination is not claimed and the device of Weil obviously secures an earpiece of the eyeglasses.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3677

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weil (US 2704961).

Weil (figures 7-12) teaches eyeglass retainers comprising a cord 13' having a first end and a second end and first and second connectors 14' coupled to the first end and second ends of the cord 13' wherein the connector has hollow portion 15 and apertures 22, 23 in the tubular wall that are inherently capable of being secured to the earpiece and the temple of eyeglasses if so desired. The connectors are comprised of rubber that is elastic and would be inherently capable of being inserted over the earpiece of less curvature than that of the shown glasses so as to be placed on the temple of the eyeglasses. Since the connectors are made of rubber the openings in the tubular wall are also expandable. The difference is that the tubular wall has more than one opening. However, the device of Weil is fully capable of functioning in applicant's manner and the elimination of one opening would not preclude the device from inherently continuing to function in a manner similar to applicant's device.

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spina (US 3397026) in view of Weil (US 2704961).

Spina (figures 1, 2) teaches eyeglass retainer structure with a cord having two ends with integral loops tightened by sleeves 26 to engage either the earpieces as shown in figure 1 or the forward end portions of the temples comprising the knuckles 42. The difference is that it does not have connectors coupled to the ends of the cord. The device can secure the eyeglasses from the neck or around the head. However, Weil

Art Unit: 3677

(figures 7-12) teaches eyeglass retainers comprising a cord 13' having a first end and a second end and first and second connectors 14' forming chambers coupled to the first end and second ends of the cord 13' wherein the connector has hollow portion 15 and apertures 22, 23 in the tubular wall that are inherently capable of being secured to the earpiece and the temple of eyeglasses if so desired. The connectors are comprised of rubber that is elastic and would be inherently capable of being inserted over the earpiece of less curvature than that of the shown glasses so as to be placed on the temple of the eyeglasses. Since the connectors are made of rubber the openings in the tubular wall are also expandable. It would have been obvious to modify the retainer of Spina so that there are connectors coupled to the ends of the cord in view of Weil (figures 7-12) teaching eyeglass retainers comprising a cord 13' having a first end and a second end and first and second connectors 14' coupled to the first end and second ends of the cord 13' wherein the connector has hollow portion 15 and apertures 22, 23 in the tubular wall that are inherently capable of being secured to the earpiece and the temple of eyeglasses if so desired.

Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Spina (US 3397026) in view of Weil (US 2704961) as applied to claim 1 above, and further in view of Seron (US 4790646).

Further modification of the retainer of Spina such that adhesive connects the connectors to the intermediate flaccid connector would have been obvious in view of Seron suggesting utilizing adhesive to secure the connectors to the intermediate flaccid connector as providing sufficient strength in this field of endeavor.

Art Unit: 3677

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spina (US 3397026) in view of Seron (US 4790646).

Spina (figures 1, 2) teaches eyeglass retainer structure with a cord having two ends with integral loops tightened by sleeves 26 to engage either the earpieces as shown in figure 1 or the forward end portions of the temples comprising the knuckles 42, thereby comprising a kit. The device can secure the eyeglasses to the neck or around the head. The difference is that it does not have connectors coupled to the ends of the cord. However, Seron (figures 1-6) teaches that it is conventional to utilize separate connectors 20 attachable to the ends the flaccid intermediate connector 14 in its as use condition so as to have a better functioning retainer. Note also that the connectors 20 also are loops adjustable by ring 30 to fit a wide range of temple widths. It would have been obvious to modify the retainer structure of Spina so that the connectors are coupled to the ends of the cord in view of Seron teaching that it is conventional to utilize separate connectors 20 attachable to the ends the flaccid intermediate connector 14 in its as use condition so as to have a better functioning retainer in the environment of the connectors 20 also being loops adjustable by ring 30 to fit a wide range of temple widths. As to claims 22 and 23, these methods are obvious over the teachings of Spina that teaches securing the device to the earpiece or temple in view of Seron teaching the use of separate connectors.

Allowable Subject Matter

Claims 14-16 are allowed.

Art Unit: 3677

Claims 11, 12, and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed April 22, 2003 and August 14, 2003 have been fully considered but they are not persuasive.

As to claim 8, Weil discloses an elastic device inherently capable of functioning in applicant's manner so applicant's functional statement is met. This claim does not claim the combination and is not couched in means plus function language as is claim 1. Therefore, the claim is of broader scope and met by Weil.

Spina is a strong reference showing the desirability of securing an eyeglass retainer to either the temple or earpiece and thus serves as a primary reference for those claims reciting the combination of retainer and eyeglasses or the means plus function claims as indicated above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


Art Unit: 3677

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on M, W & F 5:30-1:30, T 5:30-2:00 & TH 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



James R. Brittain
Primary Examiner
Art Unit 3677

JRB